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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/442,256**

Applicant(s)

**YIGZAW**

Examiner  
**DR. HERBERT J. LILLING**

Group Art Unit  
**1651**



X Responsive to communication(s) filed on Feb 1, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

X Claim(s) 2-53 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

X Claims 2-53 are subject to restriction or election requirement

## Application Papers

X See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some\* ☐ None ☐ of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e)

## Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

X Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

1. Receipt is acknowledged of the preliminary amendment filed February 01, 2000.

2. Claims 2-53 are now present in the instant application.

Claim 1 has been cancelled.

3. Restriction to one of the following inventions is required under

35 U.S.C. 121:

I. Claims 2-21, drawn to a composition, classified in class 424, subclass 195.1.

II. Claims 22-40, drawn to a method of producing a composition of extracts of plant material, classified in class 424, subclass 195.1.

III. Claims 41-53, drawn to a method of treating, classified in class 424, subclass 195.1.

4. The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process e.g. extracts of other plants or by organic synthetic methods.

Art Unit:

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case , the product as claimed can be used in a materially different process of using that product e.g. treating patients for lowering cholesterol or controlling triglycerides.

5. Because these inventions are distinct for the reasons given above have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one invention is not required for the other invention, thusly the restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Whereby the composition is obtained from the group consisting of

- a.> Glinus lotoides
- b.> Ruta chalepensis
- c.> Hagenia abyssinica

Art Unit:

or

d.> *Millettia ferruginea*.

II. Whereby extract is obtained with a solvent selected from the group consisting of

a.> organic solvents

1.> polar solvent

aa.> methanol

bb.> acetone

2.> non-polar solvent

aa.> hexane

bb.> ether

b.> cell media

aa.> 10% serum DMEM

bb.> serumless DMEM

cc.> RPMI 1640

dd.> HAM's F12

ee.> CMRL 1066

ff.> McCoy's 5A

gg.> Medium 199

Art Unit:

hh.> Waymouth MB752

ii.> Eagle MEM

jj.> Joklik MEM

kk.> alpha-MEM

c.> water

III. Whereby the plant material is selected from the group consisting of

a.> flowers

b.> leaves

c.> seeds

d.> stems

e.> mixtures of above-please specify.

IV. Whereby the composition comprises

a.> one extract of the plant material

b.> two extracts of the plant materials-please specify

c.> more than two extracts of the plant materials-please specify.

V. Whereby the treating method employs a composition the group consisting of

a.> *Glinus lotoides*

b.> *Ruta chalepensis*

c.> *Hagenia abyssinica*

Art Unit:

or

d.> Millettia ferruginea.

And

VI. Whereby the treating method is selected for

a.> cancer

1. Breast cancer
2. Prostate cancer
3. Leukemia
4. Melanoma
5. Myeloma

b.> HIV

c.> other than a. or b. viral infections

d.> diabetes

e.> Parkinson's disease

f.> tuberculosis

g.> fungal infections

Art Unit:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**APPLICANT IS REQUIRED TO SELECT ONE SPECIES FROM EACH OF THE ABOVE GROUPS I-VI AND SUBGROUPS IF APPROPRIATE FOR THE ELECTED INVENTION AND SPECIES.**



Art Unit:

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention I-II-III (as submitted in above paragraph 4) as well as elections of species as noted in the above paragraph 6) to be examined even though the requirement be traversed (37 CFR 1.143).

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

9. Applicant has noted that Claims 2-53 are fully supported by the specification and no new matter has been added. In order to avoid any rejections for non-support and for clarification and support for each of the added claims, Applicant is kindly requested to clearly note the support **for each and every limitation as claimed for support in the specification by page no and line no.** Applicant is not required at this time to submit the above but this Examiner may not be able to perform a full search and examination of the claimed inventions based on the new claims.

Art Unit:

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is (703) 308-2034 and fax number (Art Unit 1651) is (703) 305-7939 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL

(703) 308-2034

Art Unit 1651

May 19, 2000

*Herbert J. Lilling*  
HERBERT J. LILLING  
PATENT EXAMINER  
GROUP 160- ART UNIT 1651